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EXAMINER

ALAM, SHAHID AL

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/730,219
Filing Date: December 05, 2000
Appellant(s): CHIDIAC ET AL.

MAILED

NOV 29 2006

Technology Center 2100

Lawrence Harbin
For Appellant

EXAMINER'S ANSWER

Art Unit: 2162

This is in response to the appeal brief filed September 6, 2006 appealing from the Office action mailed on April 6, 2006.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

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(8) Evidence Relied Upon

5,608,874

OGAWA et al.

'03-1997

Applicants' Admitted Prior Art (APA), Pages 1 – 4

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1 – 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Number 5,608,874 issued to Stuart Ogawa et al. ("Ogawa") and in view of Applicants' Admitted Prior Art ("APA").

With respect to claim 1, Ogawa teaches a method for selecting a file format from a plurality of stored file formats for use in performing a translation from said selected file format to a requested file format (see Abstract), the method comprising the steps of:

receiving a request for a data file in a requested format (column 34, lines 17 – 19);

determining a file format from a plurality of stored files for use in performing said translation to said requested file format (column 2, lines 30 – 36 and lines 54 – 61); and

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translating the file format of said data file determined in said determining step to the requested file format (column 2, lines 54 – 61 and column 34, lines 60 – 64) and providing the requested file format to a user (examiner interprets as displaying to user; see also column 6, lines 46 – 48 and column 23, lines 14 – 18).

Ogawa does not explicitly teach an optimal file format from a plurality of stored file formats as claimed.

APA discloses claimed optimal file format from a plurality of file format. APA discloses a requested data file exists within an enterprise in many different formats other than the requested format, . . . for selecting the optimal version of a requested data file from which to perform the translation (see APA, 2nd Paragraph of page 3).

It would have been obvious to a person of ordinary skill in the art at the time of the invention was made to combine APA with Ogawa to automatically understand what specific format translations are needed for a specific data recipient, then to be able to automatically carry out such a translation regardless of what format the data was originally in. It would be desirable for a system to operate with minimal user interaction, making it faster, cheaper, and more reliable than manual or semiautomatic performance of such tasks (column 2, lines 30 – 43; Ogawa).

As to claims 2 and 3, Ogawa teaches all of the limitation as claimed except Ogawa does not explicitly teach minimizing data loss and minimizing file size as claimed.

APA teaches claimed minimization and optimization by selecting the optimal version of a requested data file from which to perform the translation (see APA, 2nd Paragraph of page 3).

It would have been obvious to a person of ordinary skill in the art at the time of the invention was made to combine APA with Ogawa to automatically understand what specific format translations are needed for a specific data recipient, then to be able to automatically carry out such a translation regardless of what format the data was originally in. It would be desirable for a system to operate with minimal user interaction, making it faster, cheaper, and more reliable than manual or semiautomatic performance of such tasks (column 2, lines 30 – 43; Ogawa).

As to claim 4, determining step is based upon the requested file format and available stored file formats (column 34, lines 17 – 50).

As to claim 5, wherein said determining step further includes the step of consulting an optimized list of file formats from which to perform said translation of said stored data file to the requested file format (Ogawa: column 16, lines 18 – 23; Note that the “Subscriber Translation Information” of Ogawa reads on an optimized list of file formats).

As to claim 6, said list is indexed by said requested file format (column 34, lines 50 – 64).

As to claim 7, said optimized list is consulted if the data file is stored in a plurality of formats (Ogawa: column 16, lines 18 – 23; Note that the “Subscriber Translation

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Information” of Ogawa reads on an optimized list of file formats and see also APA, 2nd Paragraph of page 3).

As to claim 8, said consulting step further includes selecting one of said optimized list from a plurality of said optimized lists (Ogawa: column 16, lines 18 – 23; Note that the “Subscriber Translation Information” of Ogawa reads on an optimized list of file formats and see also APA, 2nd Paragraph of page 3).

As to claim 9, ordering of said optimized lists is based on criterion regarding the translation to be performed on the stored data file (column 2, line 59 – column 3, line 4).

As to claim 10, said criterion is defined by a received request for said data file (column 2, line 59 – column 3, line 4).

As to claim 11, accessing a portion of said optimized list ordered based upon the requested file format; determining whether one or more of said listed file formats exists as one of said stored file formats; and selecting from said optimized list the optimal file format that is determined to exist as a stored file format (a requested data file exists within an enterprise in many different formats other than the requested format, . . . for selecting the optimal version of a requested data file from which to perform the translation (see APA, 2nd Paragraph of page 3 and also Ogawa: column 16, lines 18 – 23; Note that the “Subscriber Translation Information” of Ogawa reads on an optimized list of file formats).

The subject matter of claims 12 – 23 are rejected in the analysis above in claims 1 – 11 and these claims are rejected on that basis.

(10) Response to Argument

Appellant's argument regarding the rejection of claims 1 – 23:

Argument A: Appellant argues that the passages relied on by the examiner are not, in fact, "admitted prior art" (Page 4, Brief).

Argument B: Appellant argues that Ogawa does not show "determining an optimal starting format" from which to translate a requested file a desired format (Page 4, Brief).

Argument C: The examiner concedes that Ogawa fails to disclose determining an optimal file format from which to begin a translation to a requested file format (Page 5, Brief).

Argument D: Appellant argues that the quoted passage does not characterize a pre-existing prior art system or scheme (Page 6, Brief).

Argument E: Nothing in Ogawa is said about determining an optimal one of multiple formats to begin a translation (Page 7, Brief).

Examiner's Response to Arguments:

In response to argument A:

The Appellant argues that the passages relied on by the examiner are not, in fact, "admitted prior art". In response to the argument, applicant's admitted prior art or background of the invention, the background of the invention ordinarily comprises two parts: (1) Field of the Invention: A statement of the field of art to which the invention pertains.

This statement may include a paraphrasing of the applicable U.S. patent classification definitions. The statement should be directed to the subject matter of the claimed invention. (2) Description of the related art including information disclosed under 37 CFR 1.97 and 37 CFR 1.98: A paragraph(s) describing to the extent practical the state of the prior art or other information disclosed known to the applicant, including references to specific prior art or other information where appropriate. Where applicable, the problems involved in the prior art or other information disclosed which are solved by the applicant's invention should be indicated. See also MPEP § 608.01(a), § 608.01(p) and § 707.05(b).

Examiner is entitled to give claim limitations their broadest reasonable interpretation in light of the specification. See MPEP 2111 [R-1]

During patent examination, the pending claims must be "given the broadest reasonable interpretation consistent with the specification." Applicant always has the opportunity to amend the claims during prosecution, and broad interpretation by the examiner reduces the possibility that the claim, once issued, will be interpreted more

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broadly than is justified. In re Prater, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-51 (CCPA 1969). The court found that applicant was advocating ... the impermissible importation of subject matter from the specification into the claim.). See also In re Morris, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027-28 (Fed. Cir. 1997) (The court held that the PTO is not required, in the course of prosecution, to interpret claims in applications in the same manner as a court would interpret claims in an infringement suit. Rather, the "PTO applies to verbiage of the proposed claims the broadest reasonable meaning of the words in their ordinary usage as they would be understood by one of ordinary skill in the art, taking into account whatever enlightenment by way of definitions or otherwise that may be afforded by the written description contained in applicant's specification.").

The broadest reasonable interpretation of the claims must also be consistent with the interpretation that those skilled in the art would reach. In re Cortright, 165 F.3d 1353, 1359, 49 USPQ2d 1464, 1468 (Fed. Cir. 1999).

In response to argument B:

Appellant argues that Ogawa does not show "determining an optimal starting format" from which to translate a requested file a desired format.

The invention of the Instant application entails a determination of the requested file's availability and the authorization and authentication of the requester. A requester may specify the format in which they wish to receive the data file, and facilities are provided for translating the requested file to the requested format (optimal) if the file is

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not stored in the requested format. The invention provides a repository for retaining responses to requests so as to minimize successive requests against the repository for the same data file. Moreover, in such instances wherein a requested data file requires a format translation, a facility is provided for determining the correct stored file format to use as the input for the format translation. Such a determination may be based upon criteria such as minimizing data lost as a result of the translation or minimizing processing required in performing the translation.

Ogawa discloses a method, system and apparatus, similar to instant application, for automatically receiving, at an intermediate processing location, data from a wide variety of remote sources, identifying the format of the data, translating the data to a common file format, sending the data to a recipient in an intermediate format, then translating the data to the specific format (optimal format) needed by the particular recipient (see abstract and column 2, lines 53 – 59).

In response to argument C:

Appellant argues that Ogawa fails to disclose determining an optimal file format from which to begin a translation to a requested file format.

In response, Ogawa discloses a method, system and apparatus, similar to instant application, **for automatically receiving**, at an intermediate processing location, **data from a wide variety of remote sources**, identifying the format of the data, translating the data to a common file format, sending the data to a recipient in an intermediate

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format, **then translating the data to the specific format (optimal format) needed by the particular recipient** (see abstract and column 2, lines 53 – 59).

In response to argument D:

Appellant argues that the quoted passage (cited location) does not characterize a pre-existing prior art system or scheme (Page 6, Brief).

In response to Applicants' argument that the cited location has nothing to do with applicant's invention. Examiner likes to point out that in the "Schering Corp. v. Geneva Pharmaceuticals Inc., 64 USPQ2d 1032 (DC NJ 2002) Decided August 8, 2002."

In the above case it is concluded that the prior art **disclosure need not be express in order to anticipate**. Even if a prior art inventor does not recognize a function of his or her process, the process can anticipate if that function was inherent. To establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and **that it would be so recognized by persons of ordinary skill. Inherency is not necessarily coterminous with the knowledge of those of ordinary skill in the art.** Artisans of ordinary skill may not recognize the inherent characteristics or functioning of the prior art. However, the discovery of a previously unappreciated property of a prior art composition, or of a scientific explanation for the prior art's functioning, does not render the old composition patentably new to the discoverer. Insufficient prior understanding of the inherent properties of a known composition does not defeat a finding of anticipation.

Ogawa discloses **automatic receiving data from a wide variety of remote sources**, identifying the format of the data, translating the data to a common file format, sending the data to a recipient in an intermediate format, **then translating the data to the specific format (optimal format) needed by the particular recipient** (see abstract and column 2, lines 53 – 59).

Ogawa **does not explicitly teach** an optimal file format from a plurality of stored file formats **as claimed**.

APA discloses claimed optimal file format from a plurality of file format. APA discloses a requested data file exists within an enterprise in many different formats other than the requested format, . . . for selecting the optimal version of a requested data file from which to perform the translation (see APA, 2nd Paragraph of page 3).

It would have been obvious to a person of ordinary skill in the art at the time of the invention was made to combine APA with Ogawa to automatically understand what specific format translations are needed for a specific data recipient, then to be able to automatically carry out such a translation regardless of what format the data was originally in. It would be desirable for a system to operate with minimal user interaction, making it faster, cheaper, and more reliable than manual or semiautomatic performance of such tasks (column 2, lines 30 – 43; Ogawa). APA teaches claimed minimization and optimization by selecting the optimal version of a requested data file from which to perform the translation (see APA, 2nd Paragraph of page 3).

In response to argument D:

Appellant argues that nothing in Ogawa is said about determining an optimal one of multiple formats to begin a translation.

As describe above, Ogawa's invention is similar to instant application for automatically receiving, at an intermediate processing location, data from a wide variety of remote sources, identifying the format of the data, translating the data to a common file format, sending the data to a recipient in an intermediate format, then translating the data to the specific format (optimal format) needed by the particular recipient. Ogawa's system utilizes internal databases which allows it to know what format data will arrive in, what format to translate it to, and how many transactions to bill a data-receiving subscriber for. The system performs data translation and transfer, and performs validation, exception reporting, data analysis, and generates and sends receipts (see abstract and column 2, line 53 – column 3, lines 4).

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

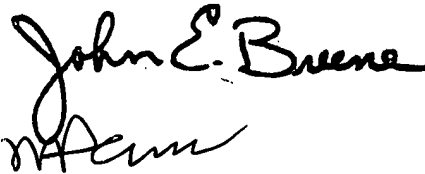
Respectfully submitted,



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